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Georg Mayer

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32294 7590 07/16/2009
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EXAMINER

PHAM, TIMOTHY X

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Continuation Sheet

Continuation of 11:

Regarding the rejection of claims 25, 26, 37, 38, 43, and 45 were rejected under 35 U.S.C. §102(b) as being anticipated by Phan-Anh (WO 02/091785), Applicant argues that Phan-Anh fails to disclose or suggest all of the elements of the claims defined in this application that "determine that a first network element in a communications network is out of service by sending a request to the first network element from the apparatus and determining that no response has been received from the first network element at the apparatus. Other operations include, when the first network element is determined to be out of service, drop a bearer configured to signal between the apparatus and a communications network comprising the first network element. Further operations include to discover or select at the apparatus a second network element, and to send from the apparatus to the second network element a message comprising an initial request for registration at the communications network" (Remark: page 16, 2nd paragraph). In response, the Examiner respectfully disagrees. Phan-Anh does not explicitly teach that the method is dropping a bearer for signalling between the apparatus and a communications network comprising the first network element. However, Phan-Anh teaches the new bearer must be established or the subscriber must be re-allocated to another S-CSCF, when a first S-CSCF serving a subscriber fails or goes otherwise out of service (page 4 lines 23 through col. 5 line 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to understand that when the first network element is determined to be out of service, drop a bearer for signalling

Art Unit: 2617

between the apparatus and a communications network comprising the first network element.

Regarding the rejection of claims 1, 3-15, 17, 19, 21-24, 34, 39-42, and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Phan-Anh (WO 02/091785) in view of 3GPP (3rd Generation Partnership Project; Technical Specification Group Service and System Aspects; Telecommunications Management; Charging Management; Charging data description for the IP Multimedia Subsystem (Release 5) 3GPP TS 32.225 v2.0.0 (2002- 09)), Applicant argues that Phan-Anh fails to teach or suggest the features of: “determining at a first network element the type of the first message; and in dependence on the type of the first message, sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service. The Office Action suggests that Phan-Anh could be combined with the description of 3GPP to provide a combination of features as required by the independent claims. However, the description of Phan-Anh would be frustrated by modifying the arrangement to incorporate the features of 3GPP. Therefore, there is no motivation for a person skilled in the art to combine Phan-Anh and 3GPP” (Remarks: page 26, last paragraph). In response, the Examiner respectfully disagrees.

MPEP 2144 states that the strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. In re Sernaker, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick, 464 F.3d 1356, 1368, 80

Art Unit: 2617

USPQ2d 1641, 1651 (Fed. Cir. 2006). As stated in the last Office Action, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to determine at the first network element the type of the first message; and in dependence on the type of the first message sending from the first network element to the user equipment an error message including an indication that the serving network element is out of service, and subsequent to sending the error message to the user equipment to enhance managing communications over a network. Therefore, the Examiner clearly articulated and made explicit why the claimed invention would have been obvious and provided rationales for combining the cited reference as is required by applicable law and the MPEP and cited evidence of record to support the combination of references.

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617